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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,992	05/03/2001	Wilfried Lubisch	49500	7169

26474 7590 12/04/2002

KEIL & WEINKAUF  
1350 CONNECTICUT AVENUE, N.W.  
WASHINGTON, DC 20036

EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 12/04/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.



## UNITED STATES DEPARTMENT OF COMMERCE

## Patent and Trademark Office

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13

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

## OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on September 20, 2002☒ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.A shortened statutory period for response to this action is set to expire 3 month(s), ~~or thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1-26 are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-26 are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/830,992

## DETAILED ACTION

Claims 1-26 are pending in the application.

### *Response to Amendment*

The amendment to the specification per Amendment C filed July 23, 2002 {Paper No. 10} has not been entered since the wrong page number and line numbers were identified.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C.

112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that

the inventor(s), at the time the application was filed, had possession of the claimed invention.

No support in the specification or the original filed claims can be found for  $R^2$  representing "NR<sup>22</sup>R<sup>23</sup>" in claims 1 and 2 or  $R^2$  representing "OH" in claim 1. Applicants did not show where support (page number and line number) where support could be found in either the specification or the original filed claims. Therefore, the claims lack written description as such.

The definition of K in claim 1 is not supported in the specification or the original filed claims. Originally, the K variable represented a phenyl which may carry at most two substituents R. Applicants have not shown where support (page number and line number) where support could be found in either the specification or the original filed claims. Therefore, the claims lack written description as such.

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The definition of the K variable in claim 1 is confusing. There are definitions for  $R^{k1}$  and  $R^{k2}$  but it is not clear what these variables are defining since they do not appear in any variable definitions or any of the substituents. It is not clear if K represents a substituent other than phenyl or if the substituents starting at "or  $NH-C_1-C_4$ -alkylphenyl" are possible substituents on the phenyl ring or if the substituents are defining  $R^{k1}$  and  $R^{k2}$ . Originally, the K variable represented a phenyl which may carry at most two substituents R.

Claims 2 and 3 are replete with variables and substituents that lack antecedent basis from claim 1. See in claim 2, for example, wherein definition of  $R^3$  (e.g.,  $R^{31}$ , m, n, etc.);  $R^4$  being  $OR^{41}$ .



A DOCPHOENIX - Test CanonIR110

**APPL PARTS**

IMIS	_____
Internal Misc. Paper	_____
LET.	_____
Misc. Incoming Letter	_____

371P \_\_\_\_\_  
PCT Papers in a 371 Application

A... \_\_\_\_\_  
Amendment Including Elections

ABST \_\_\_\_\_  
Abstract

ADS \_\_\_\_\_  
Application Data Sheet

AF/D \_\_\_\_\_  
Affidavit or Exhibit Received

APPENDIX \_\_\_\_\_  
Appendix

ARTIFACT \_\_\_\_\_  
Artifact

BIB \_\_\_\_\_  
Bib Data Sheet

CLM \_\_\_\_\_  
Claim

COMPUTER \_\_\_\_\_  
Computer Program Listing

CRFL \_\_\_\_\_  
All CRF Papers for Backfile

DIST \_\_\_\_\_  
Terminal Disclaimer Filed

DRW \_\_\_\_\_  
Drawings

FOR \_\_\_\_\_  
Foreign Reference

FRPR \_\_\_\_\_  
Foreign Priority Papers

IDS \_\_\_\_\_  
IDS Including 1449

NPL \_\_\_\_\_  
Non-Patent Literature

OATH \_\_\_\_\_  
Oath or Declaration

PET. \_\_\_\_\_  
Petition

RETMAIL \_\_\_\_\_  
Mail Returned by USPS

SEQLIST \_\_\_\_\_  
Sequence Listing

SPEC \_\_\_\_\_  
Specification

SPEC NO \_\_\_\_\_  
Specification Not in English

TRNA \_\_\_\_\_  
Transmittal New Application

CTNF \_\_\_\_\_  
Count Non-Final

CTRS \_\_\_\_\_  
Count Restriction

EXIN \_\_\_\_\_  
Examiner Interview

M903 \_\_\_\_\_  
DO/EO Acceptance

M905 \_\_\_\_\_  
DO/EO Missing Requirement

NFDR \_\_\_\_\_  
Formal Drawing Required

NOA \_\_\_\_\_  
Notice of Allowance

PETDEC \_\_\_\_\_  
Petition Decision

**OUTGOING**

CTMS	_____
Misc. Office Action	_____

1449 \_\_\_\_\_  
Signed 1449

892 \_\_\_\_\_  
892

ABN \_\_\_\_\_  
Abandonment

APDEC \_\_\_\_\_  
Board of Appeals Decision

APEA \_\_\_\_\_  
Examiner Answer

CTAV \_\_\_\_\_  
Count Advisory Action

CTEQ \_\_\_\_\_  
Count Ex parte Quayle

CTFR \_\_\_\_\_  
Count Final Rejection

AP.B \_\_\_\_\_  
Appeal Brief

C.AD \_\_\_\_\_  
Change of Address

N/AP \_\_\_\_\_  
Notice of Appeal

PA.. \_\_\_\_\_  
Change in Power of Attorney

REM \_\_\_\_\_  
Applicant Remarks in Amendment

XT/ \_\_\_\_\_  
Extension of Time filed separate

BACKFILE DOCUMENT INDEX SHEET

**Internal**

SRNT \_\_\_\_\_  
Examiner Search Notes

CLMPTO \_\_\_\_\_  
PTO Prepared Complete Claim Set

WCLM \_\_\_\_\_  
Claim Worksheet

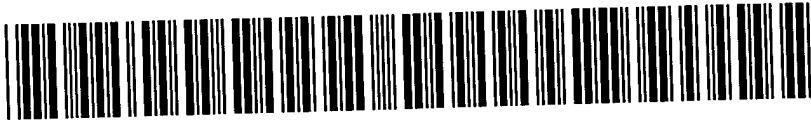
WFEE \_\_\_\_\_  
Fee Worksheet

**File Wrapper**

FWCLM \_\_\_\_\_  
File Wrapper Claim

IIFW \_\_\_\_\_  
File Wrapper Issue Information

SFRW \_\_\_\_\_  
File Wrapper Search Info



Creation date: 23-06-2003  
Indexing Officer: PHOENIX - PHOENIX  
Team: PhxAdministrator  
Dossier: 09830992

Legal Date: 20-09-2002

No.	Dccode	Number of pages
1	A...	1
2	CLM	5
3	REM	20

Total number of pages: 26

Remarks:

Order of re-scan issued on .....